



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,288	08/23/2001	Gerald A. Pierson	18554F	1186
7590	11/17/2004		EXAMINER	
Jeffrey S. Whittle, Esq. Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A. P.O. Box 3791 Orlando, FL 32802-3791			VARGOT, MATHIEU D	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/938,288	PIERSON ET AL.
	Examiner Mathieu D. Vargot	Art Unit 1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 42 and 43 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 42 and 43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date, _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/30/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

1. Applicant's election with traverse of Group II, claims 42 and 43 in the reply filed on August 23, 2004 is acknowledged. The traversal is on the ground(s) that there would be no burden imposed on the examiner to search both inventions. This is not found persuasive because there would be a burden in considering the additional claims. However, this is moot at this point in that the non-elected claims 35-41 have been cancelled by applicant.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 43, penultimate line, "the major elevational portion" lacks antecedent basis.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohde et al (see col. 4, lines 29-37).

The applied reference discloses that it is known in the art to die-cut or stamp a non-circular shape on a CD substrate on which data will be provided, the die cutting or stamping using a mold to provide the spaced apart outer side peripheries which define boundaries of the surface on which the data is encoded. Hence, it is submitted that Rohde et al recognizes that such compact discs would be molded as set forth in instant

claim 42. The applied reference fails to disclose the exact instant arcuate sides extending between linear sides—ie, the exact non-circular shape. However, it is submitted that this would have been well within the skill level of the art dependent on the exact purpose for the CD and desired shape therefor. Note that the heart shape shown in Rohde et al shows two arcuate sides and two linear sides, although these are not arranged exactly as instantly claimed. Again, the exact shape in which the CD is molded is submitted to have been well within the skill level of the art dependent on the exact design desired for the CD. Rohde et al also shows positioning an opening in the medial portion of the disc and it is submitted that the exact value for the radius (r) would have been obvious dependent on the exact size desired for the CD.

4. Applicant's arguments with respect to claims 42 and 43 have been considered but are moot in view of the new ground(s) of rejection.

In view of the election, the rejection has been changed and hence arguments directed to Smith et al are now not in point. Needless to say, Rohde et al shows die stamping using molds and this is submitted to be within the meaning of molding as recited in the instant claims.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sabatini (passage bridging columns 3 and 4) discloses that a non-circular CD would be molded in the desired shape. Mehta et al and Lowenstein show credit or business card CD's similar to the instant shape.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
November 12, 2004

M. Vargot
Mathieu D. Vargot
Primary Examiner
Art Unit 1732
11/12/04